

Eisenfuhr 9998.2 -HCL
HA 3790-04US HSE/nb

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: STEINBUCHER et al.
SERIAL NO.: 09/750,986
FILED: 28 December 2000
FOR: SYNTHETIC ENZYMES FOR THE PRODUCTION OF CONIFERYL ALCOHOL, CONIFERALDEHYDE, FERULIC ACID, VANILLIN AND VANILLIC ACID AND THEIR USE
ART UNIT: 1852
EXAMINER: Della Ramirez

1 December 2004

Technology Center 1800
Group Director 1850 (Bruce Kisliuk)
Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition for Requirement of Restriction Under 37 CFR 1.144

SIR:

In response to the finality of the restriction and election of species requirement issued by the examiner in Paper No. 20 dated 17 October 2002, please accept this petition to reconsider the restriction requirement of Paper No. 18 dated 2 July 2002.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

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HA 3790-04US HSE/nb**REMARKS*****History of Prosecution in Parent Application***

The present application is a divisional of SN: 08/976,063. The claims in the '063 was subject to a restriction requirement by Examiner Peter Tung (see copy of Paper No. 9, mailing date 7 August 1998 attached to this petition). Examiner Tung telephoned the applicants with his proposed election of species/restriction requirement and the applicants elected the invention directed toward eugenol hydroxylase (see claims for resulting U.S. Patent 6,524,831).

Claims of Present Application

This divisional application was filed to recover the subject matter of the original filed claims which were not prosecuted in the '831 patent. Therefore, the applicants presumed that the Examiner Ramirez would merely adopt the election/restriction requirement of Examiner Tung.

However, Examiner Ramirez drafted a 20-way restriction??? which required the applicants to first select a single invention and then subjected this single invention to an election of species requirement. MPEP 803 states in part that "If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions." There is absolutely no indication as to why the examination of the claims permitted in the '831 patent now suddenly constitutes an undue burden on the Examiner with regard to the species of ferulic acid deacylase. In addition, although the applicants are not asking for relief in terms of also rescinding the election of species requirement, the Examiner's first office action on the merits suggests that even the election of species may not be an undue burden (see the 102(a) and 102(b) rejections on page 9 of the office action. The rejections are directed toward the non-elected elements of claim 1:

eugenol → coniferyl alcohol → coniferaldehyde → **ferulic acid → vanillin** → vanillic acid

(the applicants elected ferulic acid deacylase which is used to convert ferulic acid to vanillin. The Examiner's rejection based on Priefert et al. taught the conversion vanillin to vanillic acid whereas the rejection by Jaeger et al. teaches the use of coniferaldehyde dehydrogenase to convert coniferyl alcohol into coniferylaldehyde.

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Moreover, despite the fact that this application was filed on 28 December 2000 and had not received a communication until 4 May 2004 (admittedly some of the delay was due to correction of sequence listings), there is no record that the Examiner attempted to telephone the applicants for an oral election despite the fact that a previous election/restriction has been made in the parent application and the applicants representative previously elected over the telephone (see MPEP 812.01 - Telephone Restriction Practice).

In order to further clarify that the format, if not the scope of the claims, are substantially similar to the format found in the '831 patent, the claims have been amended to roughly correlate with the format of the claims that were allowed in the '831 patent with the present scope of the claims being directed around ferulic acid deacylase.

Therefore, for reasons of uniformity of practice and adherence to the PTO's general principles of customer service, the applicants respectfully request that the Examiner's restriction be withdrawn (the applicants accept the election of species requirement of limiting the scope of the invention to be directed toward ferulic acid deacylase).

Summary

For the reasons given above, it is believed that there is no basis for the restriction portion of the restriction/election of species requirement drafted by the examiner which was mailed on 4 May 2004. It respectfully requested that the restriction requirement be withdrawn (while maintaining the election of species requirement) and that a new office action be prepared which addresses the scope of the claims as amended and is being filed concurrently with this letter.

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A favorable decision on this petition is respectfully requested. If any further information is needed, please feel free to contact the undersigned at the telephone number below.

Respectfully submitted,
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Attachments: Copy of Paper No. 9 (mailed on 7 August 1998 - first four pages)
Copy of claims from U.S. Patent 6,524,831

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Petition for Requirement of Restriction Under 37 CFR 1.144 (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 1 December 2004

By: Agata Glinska
Agata Glinska